

REMARKS

Claims 6, 12, 13, 14, 16, 25 and 26 have been amended. New claims 30-44 have been added. Claims 1-17 and 23-44 are pending in the application.

Support for the new claims can be found throughout the specification. (See, e.g., p. 5., lines 27-30 (bar codes used for purposes different from the game and are used to identify unrelated products); p. 8, lines 19-25 (arbitrary products); p. 9, lines 1-6 (identifying products unrelated to gaming devices); p. 18, line 31 - p. 32, line 8 (codes for identifying unrelated products and correlating code to game data); p. 31, lines 21-32 (code identifying company and product; p. 22, lines 5-12)).

Claims 25 and 26 were rejected as failing to comply with the enablement requirement under 35 U.S.C. §112¶2. Applicants have amended claims 25 and 26 to clarify that the logo and color are associated with the game data, the game data being selected by the controller. Thus, claims 25 and 26 have been amended to clarify that the processor / controller does not select a logo or color. Support for the amendments can be found on page 18, lines 5-14 (discussing logo and color; identifying colors or logos with a group of game characters). Accordingly, the Applicants respectfully submit that the rejection under §112¶2 be withdrawn.

Claims 6, 12 and 14-16 were rejected under 35 U.S.C. §112¶2 for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention.

Claims 6, 12 and 14 have been amended. The Applicants note that all of these claims are directed to a “gaming device” and that claims 6, 12 and 14-16 call for particular features of the a storage medium and the processing means. Based on the amendments and remarks, the Applicants respectfully request that the rejection under 35 U.S.C. §112¶2 be withdrawn.

CLAIMS 1-6, 12-17, 23-25 AND 27-29 ARE NOVEL OVER YAMADA.

Independent claims 1, 23 and 29 and respective dependent claims 2-6, 12-17, 24, 25, 27 and 28 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,398,651 to Yamanda (“Yamada”). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP §2131 (emphasis added). The Applicants respectfully traverse the rejection. In order to expedite prosecution of the application, the Applicants offer the following remarks.

Claim 1 of the subject application calls for “a scanner for scanning a bar code corresponding to a product identification...” Claim 23 includes a similar limitation that calls for “a scanner... configured to read bar codes...” Claim 29 calls for “a scanner for scanning a product identification number of a Universal Product Code...”

The Applicants respectfully submit that Yamada fails to disclose or suggest these limitations since the cited reference does not disclose or suggest a scanner for scanning a bar code, a bar code that corresponds to a product identification, or a produce identification number of a Universal Product Code.

Yamada describes a card game device that can be used with an old card game device using additional cards and card characteristics. New cards can be added using a connector 51 and an external cord. In particular, as noted in the Office action, Yamada explains that a connector 51 is used to connect a gaming device to a source of cards that is separate from the cassette 12. Yamada explains that “by appending an identification code based on a bar code, or the like, to a card source sold separately from the cassette, and inputting this identification code as a password, it is possible also to obtain cards corresponding to this card source. (Yamada, col. 16, line 61 - col. 17, line 10). Thus, Yamada refers to appending (i.e., adding to or supplementing) an identification code that is “based on” a bar code, as opposed to using an actual bar code or a bar code that identifies an actual product. Correspondingly, Yamada clearly fails to disclose or suggest “a bar code” and “a bar code corresponding to a product identification...” limitations of claim 1 and the “bar codes” limitation of claim 23. Further, nowhere does Yamada disclose or suggest a Universal Product Code as called for by claim 29.

Applicants’ claims are fundamentally different than Yamada in this regard. For example, in embodiment of Applicants’ invention, if a bar code, such as a UPC code, is scanned, the information obtained by the scanner is the identification of the product, e.g., a gardening implement, a garment or a household product from a grocery store. This product identification information is then translated by a processing means or controller to game data. Yamada, on the other hand, does not disclose or suggest the manner in which bar codes or UPC codes of products are translated or correlated to obtain data relating to the gaming device.

Claim 1 also calls for “processing means for receiving the bar code from the scanner, for translating the bar code to game data...” Claim 23 calls for “a controller... correlates read bar

codes to one of a plurality of game data associated with a game...” The Applicants note that the Office action does not address these limitations.

Yamada is nevertheless clearly deficient with respect to claims 1 and 23. As previously discussed, Yamada merely describes “appending” an identification code that is merely “based on” a bar code. Further, Yamada does not disclose a bar code that is used for product identification. Rather, based on the limited description provided by Yamada, a bar code and a bar code that corresponds to a product identification is not read. Further, Yamada does not disclose or suggest a processing means or a controller that translate or correlate data obtained from the barcode.

Claim 29 calls for “processing means for receiving the product identification number from the scanner, for assigning a secondary meaning to the product identification number, the secondary meaning corresponding with a monster...” Yamada is clearly deficient with respect to claim 29 since Yamada merely describes “appending” an identification code that is only “based on” a bar code. Thus, the “appended” code is not a bar code or a Universal Product Code and would not be an identification number for a product since the added code sections would conceivably alter or destroy the product identification. Thus, Yamada does not disclose or suggest a processing means for receiving the product identification number from the scanner [of a Universal Product Code] and then assigning that data with a secondary meaning since the product information number is not even utilized by Yamada.

Additionally, the Applicants respectfully submit Yamada also fails to disclose or suggest “determining whether the game data [obtained by translating the bar code] are compatible game data” as recited in claim 1. The Applicants note that the Office action does not address this limitation.

Yamada, however, merely explains that it is possible to obtain cards which cannot normally be obtained by inputting a cord using the connector to obtain cards from a source that is sold separately from the cassette. Yamada does not discuss compatibility determinations in the context of a bar code corresponding to a product identification. (Yamada, col. 17, line 61 - col. 18, line 6; col. 19, lines 1-5 and 32-36).

Further, the Applicants respectfully submit Yamada does not disclose or suggest a scanner that is “disposed on a first side of the case” as recited in claim 23. Rather, Yamada

merely describes a connector 51 and a prescribed cord for connection to a card source other than a cassette 12.

Moreover, the Applicants respectfully submit that Yamada does not disclose or suggest both “a scanner disposed on a first side of the case” and “a coupling device for coupling the gaming device with a second gaming device, the coupling device comprising a transmitter and a receiver” as recited in claim 23. The Office action asserts that col. 16, line 16 - col. 17, line 10 (describing the connector 51, the prescribed cord and the appended identification code based on a bar-code) discloses a scanner with one LED for reading bar-codes. The Office action then cites the same communication control section 50 as the device that couples two gaming devices together. Claim 23, in contrast, calls for a separate scanner and coupling device components, whereas the Office action assertions regarding Yamada are contrary to these limitations.

Moreover, the Office action does not explain how Yamada discloses or suggests “a transmitter and a receiver” as recited in claim 23.

Dependent claim 6 calls for “the storage medium includes a look-up table, wherein the processing means refers to the look-up table when the processing means translates-the bar code to game data, and wherein the look-up table correlates a plurality of different bar codes to a plurality of different game data.” The Applicants respectfully submit that Yamada does not disclose or suggest a look-up table. Further, the Applicants respectfully submit that Yamada does not disclose or suggest a processing means that translates the bar code to game data. The Office action merely refers to a section of Yamada that explains that the “new” card game has more cards than the “old” card game. Yamada is clearly deficient with respect to claim 6.

Considering the forgoing remarks, Yamada is clearly deficient with respect to Applicants’ independent claims 1, 23 and 29, and respective dependent claims 2-6, 12-17, 24, 25, 27 and 28, which depend from respective independent claims 1, 23 and 29 thereto.

Moreover, considering that Yamada appends or adds to an identification code that is merely based on a bar code or the like, Yamada teaches away from the “bar code”, “bar code corresponding to a product identification”, “bar codes” and “a scanner for scanning a product identification number of a Universal Product Code...” limitations of respective claims 1, 23 and 29 since the additional or appended sections are added to a code that destroys or alters any product identification information.

DEPENDENT CLAIMS 7-10 AND 26 ARE PATENTABLE OVER YAMADA.

Claims 7-10 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada. Claims 7-10 incorporate all of the elements and limitations of independent claim 1, and claim 26 incorporates all of the elements and limitations of claim 23.

To establish a prima facie case of obviousness of a claim under 35 U.S.C. §103(a), all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art. MPEP §2143.03. Moreover, there must be some suggestion or motivation to modify the reference. MPEP §2143.01. The Applicants respectfully submit that Yamada cannot support the rejection in view of these requirements and the deficiencies of Yamada, as discussed above.

Further, the Applicants respectfully submit that there is no suggestion or motivation to modify the system described in Yamada to derive the systems recited in Applicants' claims. Applicants note that claims 1 and 7-10 call for or incorporate a scanner for scanning a bar code corresponding to a product identification ..." and claims 23 and 26 call for or incorporate "a scanner ... configured to read bar codes..." Claims 7-10 and 23 specify certain types of bar codes.

The Office action asserts that Yamada teaches a game card having bar code data. Yamada, however, specifically describes appending an identification code, but does not disclose or suggest the use of a bar code. Thus, the Office action assertions that different types of bar code encoding would be used is inconsistent with Yamada, which describes the use of an identification code that is appended or altered. Thus, the additional or appended sections that are added to a code would destroy or alter any product identification information that could possibly be discerned from the identification code and, therefore, Yamada teaches away from specific types of bar codes that identify products.

Accordingly, the Applicants respectfully request that the rejection of dependent claims 7-10 and 23 under 35 U.S.C. §103(a) be withdrawn.

DEPENDENT CLAIMS 7-10 AND 26 ARE PATENTABLE OVER YAMADA.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada in view of U.S. Patent No. 5,212,368 to Hara (“Hara”). Hara is cited as disclosing a speaker.

Claim 11 incorporates the elements and limitations of claim 1. The Applicants respectfully submit that Hara does not cure the deficiencies of Yamada and has its own deficiencies. Accordingly, the Applicants respectfully request that the rejection of dependent claim 11 under 35 U.S.C. §103(a) be withdrawn.

**NEW DEPENDENT CLAIMS 30-44 ARE PATENTABLE OVER THE
CITED REFERENCES.**

Applicants have added new claims 30-44 and respectfully submit that they are novel and non-obvious over the cited references. Claims 30-44 depend directly or indirectly from respective independent claims 1, 23 and 29 and all novel and non-obvious limitations thereto.

New claims 30-44 include limitations directed to the bar code identifying a product that is unrelated to the gaming device. Yamada clearly fails to disclose or suggest these limitations and, teaches away, from these limitations since Yamada refers to appending an identification code for a card source that is sold separately from the cassette. In other words, the card source is directly related to the game, in contrast to Applicants’ claims 30-44.

CONCLUSION.

Based on the forgoing amendments and remarks, the Applicants respectfully submit that the application is in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case. If there are any remaining issues that can be resolved by telephone, Applicants invite the Examiner to contact the undersigned at the number indicated below.

Respectfully submitted,

BINGHAM McCUTCHEN, LLP

Dated: December 17, 2004
By: 
Gary D. Lueck
Registration No. 50,791
Attorneys for Applicants

Three Embarcadero Center, Suite 1800
San Francisco, California 94111-4067
Telephone: (213) 680-6400
Facsimile: (213) 680-6499